

Remarks

Claims 1, 5, 6, 10, 11, and 19-23 were pending in the above-identified application when last examined and are presented for reconsideration and allowance.

Claim Rejection under 35 U.S.C. § 103

Claims 1, 5, 6, 10, 11, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner et al. US Patent No. 6,879,014 in view of Morris, Jr. et al. US Patent No. 6,452, 669. Applicant respectfully traverses this rejection.

Appellants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. In the rejection, the Examiner asserts that all of the elements of appellants' claim 1 can be found in the prior art references. This, however, is *not* the proper test for obviousness.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner has provided no basis for a teaching or suggestion in the prior art for combining elements as proposed in the rejection. The Examiner's argument regarding obviousness is as follows:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to *provide the optical element as a diffractive optical element*

for the optical apparatus to diffract light, as taught by Morris, Jr. et al., in the apparatus of Wagner et al., to provide a desired interference effect for optimal light transmission and propagation.

(Office action, page 3, emphasis added)

The italicized words above represent the Examiner's only explanation regarding a teaching or suggestion to combine. These words, however, are simply an *unsupported statement* made by the Examiner. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*.

For at least the above reasons, Applicant request reconsideration and withdrawal of the rejection of Claims 1 under 35 U.S.C. § 103(a).

Dependent claims 5, 6, 10, 11, and 19-23 further define patentably distinct independent claim 1. Therefore, these dependent claims are also believed to be allowable. For at least the above reasons, Applicant requests reconsideration and withdrawal of the rejection of Claims 5, 6, 10, 11, and 19-23 under 35 U.S.C. § 103(a).

Conclusion

Applicants respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby requested.

Respectfully submitted,

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